REMARKS

This application has been carefully reviewed in light of the Office Action

dated June 28, 2007. Claims 1 to 25 are pending, of which Claims 1, 7, 21, 23, 24 and 25

are independent. Reconsideration and further examination are respectfully requested.

The Office Action withdrew all prior rejections, and substituted new

rejections in their place. Applicant thanks the Examiner for her reconsideration of the

pertinence of the Cunningham and Owa patents, and for her withdrawal of reliance on

these patents in rejecting the independent claims. The new rejections are rejections under

35 U.S.C. § 103(a), primarily over U.S. Patent 5,911,044 (Lo) in view of a new citation to

U.S. Patent 6,167,462 (Davis). These new rejections are respectfully traversed, as detailed

more fully below.

Claims 1 to 6 and 18 to 20

Independent Claim 1 was rejected over Lo in view of Davis. The remaining

ones of these claims are all dependent from Claim 1, and were rejected as above, or further

in view of U.S. Patent 6,208,436 (Cunningham), U.S. Patent 6,289,371 (Kumpf '371) or

U.S. Patent 5,168,444 (Cukor). The rejections are all respectfully traversed.

Before turning to the reasons for traversal, however, Applicant respectfully

requests clarification of the nature of the rejection of Claim 1 over Lo in view of Davis.

Specifically, in entering the rejection of Claim 1, and even though the rejection was entered

under § 103(a), page 3 of the Office Action reproduces the language of Claim 1 verbatim

and asserts that each and every element of Claim 1 is found in Lo. Applicant is therefore unsure of the role of Davis in this rejection, and respectfully requests clarification of the rejection.

Turning to the reasons for traversal, it is again pointed out that the invention concerns fulfillment of a scan order over a computer network, in which the following constituent components participate in the fulfillment of the scan order: a computer terminal, an order entry server computer, and a scanner node. As explained in connection with the chart illustrated at page 7 of the Response dated February 5, 2007, the computer terminal is responsible for inputting a scan setting, and for instructing an order entry server computer to retrieve a suitable scan node and to create a scan order. For its part, the order entry server computer is responsible for responding to the instruction of the computer terminal by retrieving a suitable scanner node and creating a scan order. Finally, the scanner node is responsible for selecting a scan order from a plurality of scan orders.

Thus, as set out in independent Claim 1, one function of the computer terminal is to cause an order entry server computer to retrieve the scanner having a suitable scan capability corresponding to the input scan setting from among a plurality of scanner nodes. Correspondingly, one function of the order entry server computer is to retrieve a scanner node having a suitable scan capability from among the plurality of scanner nodes, based on the instruction by the computer terminal.

In contrast, in the applied Lo patent, client computer 102 receives scanner parameters from the scanner server 130, as explained at column 12, lines 19 to 58. However, in Lo, the client computer receives only a specific scan capability of the scanner

144. Thus, Lo does not retrieve a scanner node having a suitable scan capability corresponding to the input scan setting, as set out in Claim 1.

In addition, Lo discloses a determination as to whether there is an available workgroup scanner, as mentioned at column 14, line 8 through column 15, line 9. However, in making this determination, Lo retrieves only the available scanner, but does not retrieve a scanner node having the suitable scan capability corresponding to the input scan setting, as set out in Claim 1.

Moreover, Claim 1 has been amended as set out above, so as to specify that the scan order selected by each scanner node is designated by a user operation at the scanner node. By contrast, in Lo the scan order cannot be selected at scanner 144. This is because Lo's system restricts user operation to either one of client computer 102 or scan server 130, but not also to scanner 144. In Lo, scanner 144 can be operated only by command from the scan server 130, and the user does not operate scanner 144 other than by placing the document on the scanner.

Accordingly, it is respectfully submitted that Lo is completely different from the invention. Moreover, the patent to Davis has been reviewed, but it is not seen to supplement the above-noted shortcomings in Lo.

But in any event, Applicant respectfully submits that there has not been a fair articulation of the apparent reasons that would have prompted a person of ordinary skill in the art to combine the features of Lo and Davis, in a way that would have resulted in the invention defined by Claim 1. Page 4 of the Office Action provides the only

apparent articulation of these reasons, but Applicants respectfully submit that the stated

reasons are insufficient. Page 4 states the following:

> "Therefore it would have been obvious to one of ordinary
> skill in the art at the time the invention was made to combine the teachings
> of *Lo et al* with *Davis et al* by having the client specify the desired scanning
> functions/capabilities for a particular scan order and then implementing a
> selection process that matches the user's desired parameters with a suitable
> scanning device capable of selecting and fulfilling a user's scanning request
> job -- doing so allows the user to specific the scanner parameters and
> scanner important for the user's scanning job and furthermore allows the
> scanner to select a scan job based on the order received and a priority of a
> user."

In essence, the stated reasons provide an explanation of the advantages of a combination of

Lo and Davis, and then rely on these advantages as a rationale for combining. However,

these stated reasons do not articulate how these advantages might have been known at the

time of the invention, and thus the stated reasons incorrectly reverses the chronology

needed to establish obviousness. Put another way, recognition of advantages might in

some cases provide a motivation for changes, but to do so, the recognition of advantages

must logically precede the changes. However, in the stated reasons quoted above, the

advantages are recognized only after the changes have already been made.

It is therefore respectfully submitted that there is an insufficient articulation

of a rationale as to why those of ordinary skill would have been prompted to combine Lo

and Davis. Together with the technological deficiencies of Lo and Davis, it is respectfully

submitted that the rejection of Claim 1 must be withdrawn.

The remaining ones of Claims 3 to 6 and 18 to 20 depend from independent

Claim 1, and therefore deemed to be patentable for that reason alone. However, each claim

states additional features which are not found in the applied art when properly combined, and withdrawal of the rejection of these claims is also respectfully requested.

Claims 7 to 17 and 21 to 25

Independent Claims 7, 21, 23, 24 and 25 were also rejected under § 103(a) over Lo in view of Davis. According to page 4 of the Office Action:

> Claims 7, 21 and 23-25 contain limitations that are substantially similar to claim 1 and are therefor rejected under the same basis."

Applicant respectfully traverse the rejection of the claims, and respectfully objects to the indifferent treatment given to the subject matter recited in these claims. These claims are not "substantially similar" to Claim 1, and indeed contain features that are not found in Claim 1. These features are discussed below, and a discussion of these features is nowhere found in this Office Action, probably as a consequence of their improper treatment by the Office Action as "substantially similar" to Claim 1.

Moreover, it is respectfully pointed out that the rejection of these independent claims amounts to an improper rejection over Applicant's own disclosure (namely, Claim 1). Claims are properly rejectable over art, and are never properly rejectable over Applicant's own disclosure.

With respect to the technological content of these claims, it is true that the claims include the feature of retrieving a scan node having a suitable scan capability corresponding to an input scan setting. As mentioned above, in connection with Claim 1, Lo does not teach this feature of the claims.

In addition, these claims further include the feature that the scan order

includes an address of at least one of the individuals selecting from the group consisting of

(A) recipients of the scanned document, and (B) recipients of notification of completion of

the scan order. These features are not discussed anywhere in the Office Action. In

Applicant's view, neither Lo nor Davis discloses these features either.

In this latter regard, it should be pointed out that the Examiner herself

apparently shares this opinion. In her Office Action dated October 6, 2006, page 5 includes

the following concession:

> "Lo et al does not teach the selection of the individuals [sic,
> individual's] address from a group. Cunningham teaches selection from the
> group comprising (A) recipients of the scanned document [citation omitted],
> and (B) recipients of notifications of completion of the scan order ...".

Thus, the Examiner herself has previously conceded that Lo suffers from the exact same

deficiencies as those asserted here.

Applicant also respectfully asserts that there has been an insufficient

articulation of a rationale as to why those of ordinary skill would have been prompted to

combine Lo and Davis, with respect to the subject matter of independent Claims 7, 21, 23,

24 and 25.

It is therefore respectfully submitted that in view of the technological

deficiencies of Lo and Davis, as well as the insufficient legal foundation for combining

and/or modifying Lo and Davis, that the rejection of these claims should be withdrawn.

The remaining claims are dependent claims, and are therefore deemed to be

patentable for that reason alone. However, each claim states additional features which are

not found in the applied art when properly combined, and withdrawal of the rejection of these claims is also respectfully requested.

REQUEST FOR INTERVIEW

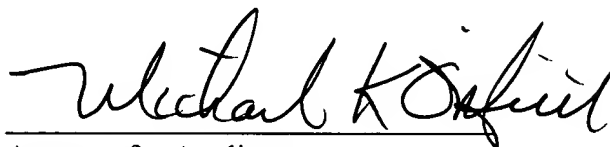This is a written request for a telephone interview with the Examiner, pursuant to MPEP § 713.01:

> "Where the reply to a first complete action includes a request for an interview, a telephone consultation to be initiated by the examiner or a video conference, or where an out-of-town attorney under similar circumstances requests that the examiner defer taking any further action on the case until the attorney's next visit to Washington (provided such visit is not beyond the date when the Office action would normally be given), the examiner, as soon as he or she has considered the effect of the reply, should grant such request if it appears that the interview or consultation would result in expediting the case to a final action."

In view of the above remarks, Applicant submits that the entire application is in condition for allowance. However, if the Examiner does not agree, Applicant respectfully requests an interview to discuss the differences between the present invention and the applied art. For his part, the undersigned will also telephone the Examiner in the following weeks in an effort to determine the status of the application, and also to schedule an interview. Accordingly, however, if the Examiner reaches this case for action before an interview has been scheduled, Applicant respectfully requests that the Examiner contact the undersigned at (714) 540-8700 for scheduling of an interview.

CONCLUSION

Applicant's undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

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